

REMARKS/ARGUMENTS

In the restriction/election of species requirement dated March 5, 2007, the Examiner delineated the following inventions as being patentably distinct.

Group I, Claims 1-13, drawn to compounds.

Group II, Claim 15, drawn to multiple uses.

The Examiner further required the election of a single species and the treatment of a specific disease.

Accordingly applicants provisionally elect with traverse Group I, the species of example 54 (page 84) and the treatment of rheumatoid arthritis as the specific disease.

The claims of Groups I and II are integrally linked as compounds and method of use.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions in regard to patentable distinction. Compounds and method of use should be examined together. It is a technical relationship that involves the same features, and it is this technical relationship that defines the contribution which each of the Groups, taken as a whole makes over the prior art.

In chemical cases, a specified group of materials which do not necessarily belong to an otherwise class can be claimed together employing "Markush" language. The Markush practice sanctions the claiming together operable substances which could not be defined by generic language but which nevertheless have a community of chemical or physical characteristics. The member of the Markush group need only possess at least one property in common which is mainly responsible for the function of the chemical relationship. In the instant application a 2-thio-substituted imidazole derivative appears to be the main nucleus in all of the claimed compounds. The same utility in a generic sense suffices.

Further, MPEP § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants submit that a search of all claims would not constitute a serious burden on the Office. In fact, the International Search Authority has searched all of the claims together. As the Office has not shown any evidence that restriction should now be required when the International Preliminary Examination Report did not, restriction is believed to be improper.

For the reasons set forth above, Applicants request that the restriction requirement be withdrawn.

Applicants request that if the invention of Group I is found allowable, withdrawn Group II, which includes all the limitations of the allowable claims be rejoined.

Applicants request that should the elected species be found allowable, the Examiner expand her search to include non-elected species.

Divisional applications filed thereafter, claiming the non-elected species should not be subject to a double patenting ground of rejection, 35 U.S.C. § 121, In re Joyce (Comr. Pats 1957) 115 USPQ 412.

Applicants submit that the above-identified application is now in condition for examination on the merits and an early notice of such action is earnestly solicited.

Respectfully submitted,

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